

**THIS OPINION IS NOT CITABLE
AS PRECEDENT OF
THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Ryan

MAILED: April 29, 2004

Opposition No. 91125615

University of Southern California

v.

University of South Carolina

**Before Hairston, Rogers, and Drost,
Administrative Trademark Judges.**

By the Board:

The University of South Carolina (applicant) has applied to register a stylized version of the interlocking letters SC, as illustrated below.¹ Registration is sought in International Class 25 for goods identified as "clothing; namely, hats, baseball uniforms, t-shirts and shorts."



The University of Southern California (opposer) has opposed issuance of a registration to applicant on the dual grounds of dilution and likelihood of confusion and priority.

¹ Application Serial No. 75358031, filed on September 16, 1987 under Section 1(a) of the Trademark Act, published for opposition on May 18, 1999.

Opposition No. 91125615

See 15 U.S.C. §§ 1052(d) and 1125(c). In the notice of opposition, opposer relies on ownership of Registration No. 1844953 for the mark SC (in typed form, i.e., devoid of any form of stylization). Opposer's SC typed mark is registered in four classes, including International Class 25 for goods identified as "sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets." The registration issued July 12, 1994.

Opposer also relies on common law rights in an "SC" mark. In paragraph 2 of the notice of opposition, opposer generally alleges use of an "SC" mark in connection with "competitive sporting events and educational services dating back to the late 1800s" and use of the "SC" mark "as a secondary source for [o]pposer's famous educational and athletic services." See also paragraph 4 of the notice of opposition. However, opposer does not expressly claim common law rights in, or registration of, any interlocking representation of an SC mark.

Applicant timely filed an answer and counterclaim, denying all salient allegations and asserting common law priority in its SC mark and asserting a counterclaim against opposer's pleaded registration. Shortly thereafter, applicant filed an amended counterclaim. The Board accepted the amended counterclaim as a matter of course, inasmuch as it was filed prior to any answer to the original counterclaim. Opposer filed a motion to dismiss the counterclaim and the counterclaim

Opposition No. 91125615

was dismissed in its entirety by decision of the Board, issued July 31, 2003.

On September 5, 2003, opposer filed a consented motion to suspend discovery through and until October 15, 2003 to permit the parties an opportunity to engage in settlement negotiations. Opposer states in its motion to suspend that, "should the parties not settle this matter by the end of September, [opposer] expects [to] draft and file a motion for summary judgment by October 15, 2003" Additionally, opposer asserts that "the parties have agreed that it would be counter-productive to expend time and resources on discovery when the matter may be resolved by settlement and/or summary judgment" ²

Once it became apparent to the parties, sometime after September 2003, that settlement was not likely, each party refocused its efforts on further litigation of this dispute: opposer, on October 15, 2003, moved for summary judgment and applicant, on October 16, 2003, moved to compel written discovery responses from opposer. Each of these motions are fully briefed.

First, we shall consider the summary judgment motion.

² The Board inadvertently overlooked this motion in its February 4, 2004 suspension order. The oversight is regretted. Nevertheless, we now grant opposer's September 5, 2003 motion to suspend in accordance with the parties' agreement.

OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer has moved for summary judgment on its claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In its motion, opposer relies on Registration No. 1844953 for the mark SC in typed form, and on Registration No. 2683137³ which covers an interlocking representation of the letters S and C, identified as the "SC Interlock" mark. Additionally, opposer relies on common law rights in these marks, as well as common law rights in another interlocking-style SC mark, identified as opposer's "Baseball Interlock" mark. See, e.g., Declaration of Elizabeth A. Kennedy at paragraphs 5 and 15 through 18, and related exhibits.

It is well settled that the Board will consider a motion for summary judgment appropriate only insofar as it is based on claims pleaded in the notice of opposition.⁴ See Fed. R. Civ.

³ It is noted that the "SC Interlock" mark registered under Registration No. 2683137 after the commencement of this proceeding, i.e., after the filing of the notice of opposition herein. However, because opposer has neither pleaded this registration nor submitted a proper status and title copy thereof, the '137 registration has not been considered in rendering our decision on summary judgment herein. Additionally, we note that the Declaration of Ms. Kennedy, submitted with opposer's summary judgment motion, does not include specific statements of current title and status of the '137 registration.

⁴ In its reply brief, opposer states that: "[opposer] pled its SC word-mark registration because that registration was in typed form and therefore contained all possible stylized forms of the SC mark. Given the broad reach of the typed-form of the SC mark, it was unnecessary to burden this Board with an exhaustive pleading of all of the different forms of the mark used"

Opposition No. 91125615

P. 56(a) and (b); see also TBMP §528.07(a)(2d. Edition, June 2003) and cases cited therein. As we compare opposer's motion to the allegations in the notice of opposition, discussed supra, we note a discrepancy between the registrations upon which opposer relies herein. Under the circumstances, we shall consider whether summary judgment is appropriate on opposer's claims of priority and likelihood of confusion, based on:

- (1) opposer's common law rights in its SC typed mark, its "Baseball Interlock" mark, and its "SC Interlock" mark⁵; and
- (2) opposer's pleaded registration for the SC typed mark, Registration No. 1844953.

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d

⁵ Although the notice of opposition does not expressly allege reliance on opposer's interlocking representations of the letters S and C, for purposes of summary judgment, we are construing paragraphs 2 and 4 of the notice of opposition to encompass opposer's claim of common law rights in the "Baseball Interlock" and "SC Interlock" marks.

Opposition No. 91125615

847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Opposer, as the party moving for summary judgment, must show, prima facie, the absence of any genuine issues of material fact as to likelihood of confusion and priority.⁶ Then, if opposer does so, it is incumbent on applicant, as the non-movant, to show that there is a genuine issue as to likelihood of confusion or priority in this proceeding.

Based on the record now before us and for the reasons discussed below, we conclude that summary judgment is inappropriate in this case.

Upon consideration of opposer's alleged common law rights and evidence thereof, we find, at a minimum, genuine issues of material fact exist as to: (1) the scope of protection to be accorded to opposer based on its common law rights in SC marks; (2) the similarities between the parties' respective marks and specifically, the commercial impressions of the parties'

⁶ Likelihood of confusion under Section 2(d) of the Trademark Act cannot be recognized where one claiming confusion does not have a right superior to the adverse party. In this case, as in all opposition proceedings founded on §2(d), opposer must prove it has superior proprietary rights in its pleaded registered mark or in its pleaded common law SC marks; opposer must also establish that there are no genuine issues of material fact regarding the existence of a likelihood of confusion between the parties' marks.

Opposition No. 91125615

respective interlocking SC marks; and (3) priority⁷ of the parties' actual stylizations of their respective marks.

Turning to opposer's pleaded registration of the SC typed mark, opposer's proof that such registration is valid and owned by opposer removes priority as an issue in regard to the goods covered by that registration. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (C.C.P.A. 1974). Nevertheless, there remain several genuine issues of material fact for trial as to the Section 2(d) claim based on the registration. At a minimum, we find genuine issues of material fact as to: (1) the scope of protection to be accorded to opposer's registered SC typed mark; (2) whether an interlocking representation of the letters S and C may be considered a reasonable form of display of opposer's SC typed mark;⁸ (3) the

⁷ Absent an amendment by opposer to its notice of opposition to rely on its registration of the SC Interlock mark, applicant's claim of priority *vis à vis* opposer's claim of common law rights in interlocking style marks is not an impermissible collateral attack. However, if opposer later amends its pleading to rely on Registration No. 2683137, applicant may not raise the issue of priority with respect to the interlocking style mark in that registration unless, and until, applicant files a proper counterclaim. See Fed. R. Civ. P. 15(a) and Trademark Rule 2.106(b)(2)(i). See also TBMP §§ 311.02(B) at fn. 211, 313.04 and 314 (2d. Edition, June 2003).

⁸ See *Jockey International, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235-36 (TTAB 1992). In this proceeding, the record includes evidence of some use by opposer of an interlocking representation of the letters S and C on clothing, although opposer's pleadings do not expressly allege such use. We need not resolve the issue of whether opposer's asserted registration of the typed SC mark may be reasonably construed to cover an interlocking representation of the letters S and C. In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990).

Opposition No. 91125615

commercial impression of opposer's SC typed mark and applicant's stylized SC mark; and (4) the significance of opposer's restriction in channels of trade, as stated in the identification of goods for opposer's pleaded registration.

These issues are sufficient to preclude entry of summary judgment in favor of opposer.

Accordingly, opposer's motion for summary judgment is **denied**.

APPLICANT'S MOTION TO COMPEL

We turn next to applicant's motion to compel opposer's responses to applicant's written discovery requests.

To the extent that applicant, by its motion, seeks to compel discovery pursuant to Trademark Rule 2.120(e), the motion is **denied** for the following reasons.

We find applicant's motion to be both premature and untimely. Insofar as it bears certificates of service and mailing on October 14, 2003, the motion was filed during the term of the parties' agreed suspension of discovery activities which, as discussed supra, has been approved by the Board. Even if we were to evaluate the timeliness of applicant's motion by its October 16, 2003 PTO mailroom date stamp, we would still find applicant's motion to be untimely. Discovery activities were effectively suspended until October 15, 2003 by virtue of the parties' September 5, 2003 scheduling agreement and were effectively tolled on October 15, 2003 upon the filing

of opposer's summary judgment motion.⁹ Cf. Trademark Rule 2.127(d) and TBMP §528.03 (2d. Edition, June 2003) and cases cited therein.

Additionally, applicant failed to comply with the requirements of Fed. R. Civ. P. 26(g) and Trademark Rule 2.120(e)(1) to make a good faith effort to resolve the parties' discovery dispute without the Board's intervention.¹⁰ The record shows no evidence or written statement pertaining to any good faith efforts by applicant to resolve the parties' discovery dispute without the Board's intervention. Accordingly, based on the record before us, we find that applicant has not demonstrated that it has engaged in sufficient good faith efforts as required by the rules governing Board procedure. See Fed. R. Civ. P. 26(g) and Trademark Rule 2.120(e)(1). See also TBMP § 523.02, fn. 284 (2d. Edition, June 2003) and cases cited therein.

Additionally, applicant's motion does not include signed copies of the interrogatory requests and requests for production of documents served on opposer, as required by applicable Board rules.¹¹ See Trademark Rule 2.120(e)(1); see

⁹ See discussion *supra* at page 3.

¹⁰ A party seeking discovery has a duty to make a good faith effort to determine why no response has been made before coming to the Board with a motion to compel. See, e.g., *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979). See also TBMP §523.02 (2d. Edition, June 2003).

¹¹ Applicant also failed to include signed proof of service of its written discovery requests on opposer.

also 37 C.F.R. § 1.4(d)(1) and TBMP § 106 (2d. Edition, June 2003).

To the extent that applicant's motion is intended to serve as a motion for discovery under Fed. R. Civ. P. 56(f), the motion is **denied**. Applicant's motion fails to include the required affidavit under Rule 56(f). Furthermore, we find no need for discovery under Rule 56(f) in this instance given the fact that applicant already has filed a complete responsive brief on opposer's summary judgment motion, with evidence, and because we are, by this decision, ruling in applicant's favor on the summary judgment issue. See also TBMP § 528.06 (2d. Edition, June 2003). There is simply no reason for applicant to include any additional evidence to "enhance" its opposition to opposer's summary judgment motion.

PROCEEDINGS RESUMED; DISCOVERY AND TRIAL DATES RESET

Proceedings are resumed. The close of discovery and trial dates are **reset** as indicated below.¹²

DISCOVERY PERIOD TO CLOSE:	September 1, 2004
30-day testimony period for party in the position of plaintiff to close:	November 30, 2004
30-day testimony period for party in the position of the defendant to close:	January 29, 2005
15-day rebuttal period for party in the position of the plaintiff to close:	March 15, 2005

¹² If the parties seek to extend the schedule in this case, any future consented motion to extend should set forth all dates in the format shown in this order. See Trademark Rule 2.121(d).

The parties are each allowed **thirty days** from the mailing date hereof to serve their respective responses to any outstanding discovery requests duly served by their adversary.

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * * * *

Notice Regarding TTAB Electronic Resources and New Rules

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.